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LEE & HAYES, PLLC
421 W. RIVERSIDE AVE, STE 500
SPOKANE, WA 99201

EXAMINER

BROOKS, MATTHEW L

ART UNIT	PAPER NUMBER
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3629

DATE MAILED: 09/08/2006

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary	Application No. 09/862,472	Applicant(s) COFANO ET AL.	
	Examiner Matthew L. Brooks	Art Unit 3629	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 16 June 2006.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-27 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-27 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. _____.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- * See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|--|---|
| 1) <input type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152) |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
Paper No(s)/Mail Date _____ | 6) <input type="checkbox"/> Other: _____ |

DETAILED ACTION

Drawings

1. The drawings are no longer objected to because Applicant has corrected them in the drawings submitted 6/16/06 (Figs 6, 7A (ie; 701), 7B, 7C, 7D, 8, 9A, 9B, and 10).

Specification

The disclosure is no longer objected to because of the fixed informalities: [0041], pg 10.

Claim Objections

2. **Claims 1-27** are NO LONGER objected to because of the following informalities:

Claim 1 and 19 → step f should state "...providing *personal* services..." / also indicate wherein claim 19 "personal services" are provided.

Claim 8 → "...wherein of the user type..."

Claim 13 → "...provide respective..."; should it be providing?

Claim Rejections - 35 USC § 112 1st

3. The following is a quotation of the first paragraph of 35 U.S.C. 112:

The specification shall contain a written description of the invention, and of the manner and process of making and using it, in such full, clear, concise, and exact terms as to enable any person skilled in the art to which it pertains, or with which it is most nearly connected, to make and use the same and shall set forth the best mode contemplated by the inventor of carrying out his invention.

4. **Claims 10-18 and 22-27** are rejected under 35 U.S.C. 112, first paragraph, as failing to comply with the enablement requirement. The claim(s) contains subject matter which was not described in the specification in such a way as to enable one skilled in the art to which it pertains, or with which it is most nearly connected, to make and/or use the invention.

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5. With respect to **Claim 10 and 22**, Applicant has not taught how to "...calculate outcome data..." And for Examiner to determine this amongst the endless possibilities would require undue experimentation.
6. With respect to **Claim 11 and 12 and 23**, Applicant has not taught how to determine a "...service usage by user..." And for Examiner to determine this amongst the endless possibilities would require undue experimentation.
7. With respect to **Claim 13 and 14 and 15 and 24**, Applicant has not taught how to calculate "...performance metrics..." And for Examiner to determine this amongst the endless possibilities would require undue experimentation. For purposes of Examination this is merely rating the doc based upon user feedback and rewarding/penalizing appropriately. (old and known with in the art see 103 below).
8. With respect to **Claim 16, and 18 and 25 and 27** Applicant has not taught how to determine a "...response based on information related to medical history/work schedule/estimated condition..." For instance IF (X) then (Y). And for Examiner to determine this amongst the endless possibilities would require undue experimentation. However for purposes of examination all the above is given their obvious interpretations. For instance if user wants to see doctor at a certain time simply schedule an appointment that best suits patient and doctors work schedule (see 103 below).
9. **Claim 2** is rejected under 35 U.S.C. 112, first paragraph, as failing to comply with the written description requirement. The claim(s) contains subject matter which was not described in the specification in such a way as to reasonably convey to one skilled in

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the relevant art that the inventor(s), at the time the application was filed, had possession of the claimed invention. Applicant is asked to show where support is for "...wherein the communication is defined based on rules applicable to the interactions".

Claim Rejections - 35 USC § 112 2nd

10. The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

11. **Claims 1-27** are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

With respect to **Claim 1 and 19**, Applicant has fixed accordingly. But now the newly amended matter in step (e) should be "determining a service response to the service request option selected..."

And as to step (h) presenting statistical information related to the interactions to an administrator associated with the one group that the user is a member of. OR something of that nature should be claimed because as it stands now it is indefinite.

12. With respect to **claim 2** the newly added limitations cause multiple problems throughout the claims in regards to indefiniteness. First off Applicants states that the "user is an employee"; certainly Applicant has meant to state here that the "patient is an employee"; otherwise there is now antecedent base for dependent claims 16 and 17. The limitation also has "new matter" implications, see above. Furtherstill; Applicant

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states that the "groups are respective employers" and "wherein a user is an employee of one of the employers". So when Examiner turns to claim 3 wherein a "user comprises", Applicant is attempting to broaden the claim 2 with dependent claim 3 which is not allowed. Further still when looking at claim 4 "if the user type is a member/employee" according to claim 2 a "user is an employee" not MEMBER/EMPLOYEE.

13. With respect to **claim 5 and 6 and 7 and 8**, it is impossible for the user type to be a service provider because the user type is already claimed to be an employee in claim 2. The same logic applies to claim 6, 7, and 8.

14. With respect to Claim 9 and 10; due to Applicants arguments Examiner is certainly confused at to Applicant's intended definition of "outcome information" vs. "calculated outcome data"

15. With respect to **Claim 11 and 12**, fail to limit claim 9 in that recording interactions already includes storing information regarding type of service provided; and as to "...providing calculated service usage ...", What is service usage and how is it calculated out? Further still how can the invention provide "calculated service usage" if the invention fails to calculate. (see 112 1st above). That being said Examiner interprets it as what is old and well known within the art of monitoring how long a user of service uses the service and then billing accordingly.

16. The terms "service partner" in claims **3, 8** and where found is a relative term which renders the claim indefinite. The term is not defined by the claim, the specification does not provide a standard for ascertaining the requisite degree, and one of ordinary skill in the art would not be reasonably apprised of the scope of the

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invention. Is this the service partner equivalent to the service provider? Please point to wherein the specification support for this is found.

17. The terms "outcome data/information" in claims **9, 10, 21, 22** and where else found is a relative term which renders the claim indefinite. The term is not defined by the claim, the specification does not provide a standard for ascertaining the requisite degree, and one of ordinary skill in the art would not be reasonably apprised of the scope of the invention. What is this the outcome of and how is it determined (see 112 1st above)? Please point to wherein the specification support for this is found. If applicant intends "outcome research" **should claim** as such.

18. **Claim 16 and 17 and 18** recites the limitation "the medical history of the *patient*" and "work schedule of the patient". There is insufficient antecedent basis for this limitation in the claim.

Claim Rejections - 35 USC § 101

19. 35 U.S.C. 101 reads as follows:

Whoever invents or discovers any new and useful process, machine, manufacture, or composition of matter, or any new and useful improvement thereof, may obtain a patent therefor, subject to the conditions and requirements of this title.

Another consideration is whether the invention produces a "concrete" result. Usually, this question arises when a result cannot be assured. In other words, the process must have a result that can be substantially repeatable or the process must substantially produce the same result again. In re Swartz, 232 F.3d 862, 864 (Fed. Cir. 2000) (where asserted result produced by the claimed invention is "irreproducible" claim should be rejected under section 101). The opposite of "concrete" is unrepeatable or unpredictable. Resolving this question is dependent on the level of skill in the art. For example, if the claimed invention is for a process which requires a particular skill, to determine whether that process is substantially repeatable will necessarily require a determination of the level of skill of the ordinary artisan in that field. An appropriate rejection under 35 U.S.C. § 101 should be accompanied by a lack of enablement rejection under

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35 U.S.C. § 112, paragraph 1, because the invention cannot operate as intended without undue experimentation. *See infra*.

20. Claims 1-27 are rejected under 35 U.S.C. 101 because applicant has left the "determining of a service response" in the hands of a doctor and cannot assure that the result is substantially repeatable or will produce the same result again and again.

Claim Rejections - 35 USC § 102

21. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

22. **Claims 1-3 and 9-12 and 16-18 and 19-23 and 25-27** are rejected under 35 U.S.C. 102(b) as being clearly taught by Patent No.: 5,911,132 (Sloane).

23. With respect to **Claim 1 and 19 and 20**: Sloane discloses

A computer implemented method of providing personal services over a computer network to members of at least one of a plurality of predefined groups, the method comprising the steps of (Applicant is directed towards the Abstract and C3, 30-35; wherein it is stated that the Sloane invention is for institutions which have medical facilities, such as schools and large businesses, thus of course the personal services are provided to a member of a predefined group.):

a. receiving a service request from a user who is a member of one of the groups (C3, 52-53 user as taught by Sloane, may be an employee of a business or member of a predefined group);

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- b. determining a user type associated with the service request (C3, 55-57);
- c. providing a menu of service request options corresponding to the determined user type (Column 3, 55-68 and C4, 5-12);
- d. receiving a selection of one of the service request option from the user (Column 3, 55-68 and C4, 5-12);
- e. determining a service response to the service request based on information related to the user (Column 3, 55-68 and C4, 5-12);
- f. providing personal services to the user in accordance with the selected service request option and the determined service response (Column 4);
- g. recording interactions while providing the selection (Column 4, 1-5); and
- h. presenting statistical information related to the interactions to an administrator associated with the one group (C4, 30-53).

24. With respect to **Claim 2**: Sloane discloses

wherein the personal services comprises healthcare related services, wherein the groups are respective employers, wherein the user is an employee of one of the employers and is receiving the healthcare related services(Applicant is directed towards the Abstract and C3, 30-35; wherein it is stated that the Sloane invention is for institutions which have medical facilities, such as schools and large businesses, thus of course the personal services are provided to a member of a predefined group.); and further comprising delivering at least one healthcare-related recommendation to the user, wherein the communication is defined based on rules applicable to the interactions. (C4, 5-10).

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25. With respect to **Claim 3**: Sloane discloses

wherein the user type comprises one of a member/employee, a service provider, an administrator, a research service, and a service partner (Column 3 and Column 4, 40-53).

26. With respect to **Claim 9 and 21**: Sloane discloses

wherein the step of recording interactions includes storing information regarding type of service provided, user requesting service, service provider information and recommendations, frequency of service provided by user and/or service provider, outcome information, feedback from user, and performance metrics (Column 4 and C7, 15-67).

27. With respect to **Claim 10 and 22**: Sloane discloses

calculating outcome data (C7, 15-67); and
providing non-confidential outcome data to a research service (C7, 15-67).

28. With respect to **Claim 11 and 23**: Sloane discloses

calculating service usage by user, service type, and outcomes (C4, 52-60); and
providing calculated service usage to an administrator (C4, 52-60).

29. With respect to **Claim 12**: Sloane discloses

determining, by the administrator, a list of services provided based on the calculated service usage information (Column 4).

30. With respect to **Claim 16 and 25**: Sloane discloses

wherein the service response is determined based on information related to the medical history of the user (C3, 50-68 and C6, 50-68).

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31. With respect to **Claim 17 and 26**: Sloane discloses wherein the service response is determined based on information related to a work schedule of the user (Column 6, 20-25).
32. With respect to **Claim 18 and 27**: Sloane discloses wherein the service response is determined based on information related to an estimated condition of the user (Column 6).

Claim Rejections - 35 USC § 103

33. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

34. The factual inquiries set forth in *Graham v. John Deere Co.*, 383 U.S. 1, 148 USPQ 459 (1966), that are applied for establishing a background for determining obviousness under 35 U.S.C. 103(a) are summarized as follows:

1. Determining the scope and contents of the prior art.
2. Ascertaining the differences between the prior art and the claims at issue.
3. Resolving the level of ordinary skill in the pertinent art.
4. Considering objective evidence present in the application indicating obviousness or nonobviousness.

35. **Claims 4-8** are rejected under 35 U.S.C. 103(a) as being unpatentable over Sloane.

Sloane teaches all of the limitations as laid out above. Most importantly for

purposes of Examiners 36th paragraph (this one), Sloane teaches an “e-doc” or providing medical services on line. Sloane also teaches that the parties involved and that have access are extensive. Sloane teaches a new/old patient may have access to the site and if new must create a user profile and after doing so may perform transactions. Sloane also teaches a user of the system may be a service provider, also Sloane’s system must have an administrator. Further still Sloane teaches a user type being research services and thus also teaches the likelihood of services partner having access.

Sloane does not teach all of the links/options that may be included and/or presented to a user, depending on user type.

However, the links/options that Applicant presents to a user type, are all obvious to one of ordinary skill in the art to include when said user type logs into said system. For instance in claim 5, including a knowledge base so a doctor may query for answers to collected symptoms or presenting links/options to a “research service” such as available databases and query takes no great stretch of the imagination, further to have done so was well known within the art, and the titles applied to the links is arbitrary design at best. It would have been obvious to one of ordinary skill in the art at the time the invention was made to include as many relevant/pertinent options to a user upon determining a user type in order to have a fully comprehensive web site that provides an array of health services.

36. Claims 13-15 and 24 are rejected under 35 U.S.C. 103 as being unpatentable over Sloane. Sloane teaches all of the claimed process steps with the exception of

receiving a feedback from a user, calculating a performance, and rewarding/penalizing in accordance thereof. Customer service is a key factor in the success of any business, whether it be brick and mortar or online. The most common vehicle for businesses to measure customer service is by asking the customers directly what they believed was good or bad about their experience with the business. Businesses have resorted to many different techniques of obtaining customer comments including comment cards, follow-up telephone calls, as well as mailing customer surveys to customers. This practice is well known in the business community and would follow in the Internet world as well where competition is sometimes worldwide and customers have a greater influence on the success of a business. Therefore, it would have been obvious to one of ordinary skill in the art at the time of the invention to have added the well-known steps of asking the customer/user for feedback and then later rewarding a customer/user based upon said feedback to the process of online health care services for the purpose of gaining information about their service performed from the customer and rewarding/penalizing a doctor based upon services rendered.

Response to Arguments

37. Applicant's arguments filed 6/16/06 (Remarks) have been fully considered but they are not persuasive.

38. With respect to REMARKS pg 12, lines 13-22; Examiner has turned to the alleged enabling paragraphs [0065] and [0066] and disagrees with Applicant's assertion. Examiner is still unable to determine what "calculating outcome data"

comprises and in fact how to do so is not even found at all in the above said paragraphs.

39. With respect to pg 13, lines 1-7 and associated claims 11, 12 and 13 the 112 1st rejection stands. Examiner has turns to the alleged supporting paragraph 87 of the specification and is unable to determine how one “calculates a service usage”. Further although Applicant tried to amend language to comply, Applicant has further muddled the issue with the newly added limitations because the “storing data that is generated” step is identical to claim 9, and hence the claim fails to limit now under 112 2nd. Further still the 112 1st stands because the Applicant claims “providing calculated service usage to an administrator” when the Applicant has failed to claim and teach “calculate” in the first place, meaning the enablement rejection stands and a new 112 rejection of missing and essential step would hold true.

40. With respect to pg 13, lines 8-20 and pg 14, lines 1-18; Examiner has turns to [0075] and the only pertinent part is “query feedback statistics on their performance”; Examiner asks is this the same as “calculating performance metrics”? IF so this is exactly what examiner has said in Action pg 8 “survey as to performance” (see 103). The 112 1st rejection stands only if calculating performance metrics is not what Examiner has stated to be as what is known in the art; ie; survey on performance.

41. With respect to pg 14, lines 18-25 through page 16, line 12;

So with respect to claim 16 “The computer implemented method according to claim 2, wherein the service response is determined based on information related to the medical history of the patient.

It appears that the service response in this scenario is determined by the doctor who is on the other end of the network making the evaluating the patient. If it is something more than this the enablement rejection stands, and the claim limitation would be exactly what was known in the art that of "based upon a patients medical history and current condition, provide to the best of the doctor's ability service". Note however the interpretation leads to a new 101 rejection in that the goal of the invention to provide services is not concrete. IN that it is left to the subjective interpretation of a doctor and that a different doctor may provide a different service and hence the invention is not substantially repeatable (see 101 above).

With the respect to the rejection of claim 17 it is withdrawn.

With respect to claim 18 it stands for the same analysis as claim 16 above.

42. With respect to pg 16 lines15-25 are now moot because the rejections have been withdrawn

43. With respect to pg 20 Examiner takes the time to point out to Applicant that the the irrelevant portions of the 2172.01 MPEP were highlighted such as "A claim which fails to interrelate essential elements of the invention as defined by applicants in the specification may be rejected under 112 2nd."

Thus as to Applicant statement lines 21-24 that if applicant. Thus irrespective of what Applicant asserts if applicant provides calculated data or whatever the case is it is essential that said data first be calculated and with out such a step applicant is missing an essential step.

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44. With respect to pg 23, lines 2-12 if Applicant wants "outcome data" to mean *outcomes research*; Applicant should claim said term or define in specification what outcome data means.

45. With respect to pg 25, lines 6-15; the 102 rejection; Applicant must have missed the statement found within Sloane that the invention was meant to be used with in large institutions such as businesses or schools; thus predefined group. Further as far as presenting information related to interactions to an administrator; Applicant is directed to look again at Sloane, also C 4, 30-55 in which Sloane records interactions and if any similar sickness are reported on the e-docs computer, the source and cause may be nipped at the bud; therefore it is inherent with in this reference that an administrator of some sort has been provided with said info.

46. With respect to pg 26, lines 10-21; Sloane's invention used in a business setting covers completely the newly added limitation wherein a group is an employer and user is an employee. Further the new limitation of claim 2 has only muddled the Applicants claims and led to a host of new indefiniteness problems. (see above)

47. With respect to the response to the 103 rejections made pg 27 and 28, Applicant has merely traversed the rejections, but as not argued anything nor specifically pointed out anything that would now make the claims allowable; except for the fact that they depend from claims the Applicant feels are allowable; thus Examiner still is convinced that the 103 rejections stand and cannot respond to Applicants assertions. Except by providing more guidance with respect to 102 rejections made.

Conclusion

48. The prior art made of record and not relied upon is considered pertinent to applicant's disclosure.

A. www.e-med.com retrieved from the wayback machine and can be pulled back with a date up to 1 year before filing date and before Applicant's provisional.

B. Pub. No.: US 2002/0065682 A1 (Goldneberg).

C. Patent No.: 5,517,405 (McAndrew) → Teaches automatic rule engine diagnosis of patient on line and recording thereof in database; also see C2 for knowledge base, news, and recommendations

D. www.bestdoctors.com from wayback machine which can be pulled as far back as 1/25/1999.

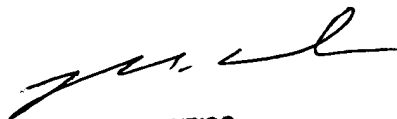
E. Patent Nos.: 5,301,105 and 6,283,761 and 5,553,609

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Matthew L. Brooks whose telephone number is (571) 272-8112. The examiner can normally be reached on Monday - Friday; 8 AM - 5 PM.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, John Weiss can be reached on (571) 272-8112. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

MLB
9/5/06



JOHN G. WEISS
SUPERVISORY PATENT EXAMINER
TECHNOLOGY CENTER 3600